

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-9 are pending in this application. Claims 1, 7 and 9 are independent and hereby amended. Support for this amendment is provided throughout the Specification. No new matter has been introduced. Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicant is entitled.

Claims 1, 7 and 9 have been amended, thereby rendering the 35 U.S.C. §112 rejections moot.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-9 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,640,301 to Ng (hereinafter, merely "Ng"), in view of U.S. Patent No. 6,327,656 to Zabetian (hereinafter, merely "Zabetian"), in further view of Applicant's Admitted Prior Art, and further in view of U.S. Patent No. 6,769,012 to Liu et al. (hereinafter, merely "Liu").^{1,2}

¹ Applicants submit that on page 6 of the Office Action, the Examiner cites Liu as to reject recitations of the claims.

² Page 3 of the Office Action states that claims 1-3, 5 and 7-9 are rejected under 35 U.S.C. §103(a), but pages 3-8 indicates that claims 1-9 are rejected; therefore, to expedite prosecution, the rejection will be responded to as claims 1-9.

Claim 1, recites *inter alia*:

“A communication contents certification system:

...wherein a reply message in response to a received electronic mail transmission is prepared with reference to a comment provided from one of said two or more attorney communication terminals, and

wherein the charging means perform charge processing to charge at least one of the parties for at least one of authenticating and certifying the contents of the electronic mail, and

wherein the communication contents storage means stores the communication history of the electronic mail.” (emphasis added)

As understood by Applicant, Ng relates to certification and authentication of emails by an authentication service. The authentication service is integrated with an email web site that allows users to set up email accounts. Outgoing email from the email web site is routed to the authentication service. A message identifier (ID) is generated and added to the message within markers. A random-number generator creates random pad characters that are added to the message before a checksum is generated. The email with the message ID in the markers but without the pad characters or checksum is sent to the recipients, along with instructions on how to authenticate the message. Others can authenticate a message by emailing it to the authentication service. The message ID is extracted from the markers and pad characters are again added to the message, and a new checksum generated. Authentication fails when the checksums do not match.

As understood by Applicant, Zabetian relates to time-stamping and verifying time-stamps for documents transmitted using network resources. Pursuant to a request to certify a document, a digital signature is extracted from the document. The digital signature corresponds to the content of the document and is unique. A certification provider maintains the

digital certification signature, an identification code such as a serial number, and other information such as the time and date of certification. The certification can be used to provide an electronic timestamp for a document, thus providing proof of possession of the document at the time of certification.

On page 6 of the Office Action, the Examiner relies on Liu to reject the recitation of “wherein the communication contents storage means stores the communication history of the electronic mail”. Applicants submit that the effective filing date of Liu is July 24, 2000.

Accordingly, Liu is disqualified as prior art because the effective filing date of the present application is March 31, 2000. Applicant submits herewith a certified English translation of Japanese Application No. P2000-098075. Thus all of the outstanding rejections based upon Liu in the above-noted Office Action are overcome.

Furthermore, it is respectfully submitted that Ng and Zabetian, taken alone or in combination do not teach or suggest the above-identified features of claim 1. Specifically, Ng and Zabetian fail to teach a communication contents certification system wherein the communication contents storage means stores the communication history of the electronic mail, as recited in claim 1.

Therefore, Applicant respectfully submits that independent claim 1 is patentable.

Independent claims 7 and 9 are method and computer-readable medium claims that include the corresponding authentication and charging features discussed above and are believed patentable for similar reasons.

Therefore, Applicant respectfully submits that independent claims 1, 7 and 9 are patentable.

III. DEPENDENT CLAIMS

The other claims in this application are each dependent from one of the independent claims discussed above and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION


In the event the Examiner disagrees with any of statements appearing above with respect to the disclosures in the cited references it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

By 
Thomas F. Presson
Reg. No. 41,442
(212) 588-0800